

10-06-08

IN/2619



Docket No.: P/54265

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. **EV667153322US** in an envelope addressed to: Mr. Petitions, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on:

October 3, 2008
(date)

Lori G. Wilkin
Lori G. Wilkin

In re: Application of : Mark T. JEFFREY, et al.

Serial No. : 08/872,078

Group Art Unit: 2619

Filed : June 10, 1997

Examiner: J. Pezzlo

For : STM SWITCHING ARRANGEMENT

New York, New York
October 3, 2008

**PETITION TO WITHDRAW HOLDING OF
ABANDONMENT UNDER 37 C.F.R. §1.181**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned is and has always been the attorney of record in the referenced application. The address of the firm of the undersigned is and has always been the correspondence address of record. Yet, for several years, the undersigned has not received any correspondence from the U.S. Patent and Trademark Office (PTO) and has not been able to learn the status of this

application, despite repeated telephone calls, until August 8, 2008, when Examiner Pezzlo advised the undersigned that this application was abandoned for failure to pay the required issue fee due November 13, 2001.

However, the undersigned, being duly sworn, states that no Notice of Allowance or Notice of Abandonment were ever received by the undersigned or his firm, and hereby petitions that the abandonment be withdrawn and the referenced application be revived based on the following facts and circumstances.

1. The last communication from the undersigned to the PTO is a communication on the merits to Examiner Luther of Art Unit 2731. A copy of that communication is enclosed and marked as *Exhibit 1*, and is stamped as received by the PTO on September 15, 2000.

2. Having received no response, the undersigned repeatedly telephoned Examiner Luther and Director Jin F. Ng of Technology Center 2700, but those calls were never returned. The undersigned has since learned that these individuals are no longer employees of the PTO.

3. The undersigned then telephoned Examiner Powell of Technology Center 2600, who in turn referred the undersigned to Examiner J. Patel, who in turn referred the undersigned to Examiner Pezzlo. Examiner Pezzlo eventually retrieved the file wrapper of the referenced application from storage.

4. The file wrapper revealed that a Notice of Allowance was mailed on August 13, 2001 ***to the wrong attorney and to the wrong address***. A copy of that Notice of Allowance is enclosed and marked as *Exhibit 2*, and is addressed to “James Dean Johnson, Jones and Askew, 191 Peachtree Street N.E., 37th Floor, Atlanta, Georgia 30303-1769”. This is ***not*** the attorney of record

or the correspondence address of record. The undersigned states that this Notice of Allowance was *not* forwarded to, or received by, the undersigned.

5. The file wrapper also revealed that a Notice of Abandonment was mailed on May 6, 2002 *to a different wrong attorney and to a different wrong address*. A copy of that Notice of Abandonment is enclosed and marked as *Exhibit 3*, and is addressed to “John S. Pratt, Esq., Kilpatrick Stockton LLP, 1100 Peachtree Street, N.E., Suite 2800, Atlanta, Georgia 30309”. This is *not* the attorney of record or the correspondence address of record. The undersigned states that this Notice of Abandonment was *not* forwarded to, or received by, the undersigned.

6. Examiner Pezzlo issued an Interview Summary confirming the above. A copy of that Interview Summary is enclosed and marked as *Exhibit 4*. Examiner Pezzlo suggested that the undersigned file a Change of Correspondence Address so that future correspondence be correctly directed by the PTO to the correct attorney and address of record. A copy of that Change of Correspondence Address is enclosed and marked as *Exhibit 5*.

Under the circumstances, no Petition Fee is believed to be necessary under Rule 1.181. Clearly, applicants should not be penalized because the PTO sent correspondence to the wrong address, more than once. If, however, a petition fee is deemed appropriate, then the Commissioner is authorized to charge such fee to Deposit Account 11-1145.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and

that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C.

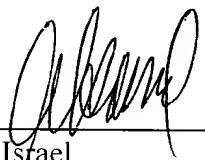
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New York, New York 10016-2223

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Fax: (212) 949-1690



Alan Israel

Reg. No. 27,564






GP 2731

#21



PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:
September 5, 2000
(date) 
Alan Israel
Reg. No. 27,564

RECEIVED
SEP 15 2000
TC 2700 MAIL ROOM

In re: Application of : Mark T. JEFFREY, et al.
Serial No. : 08/872,078 Group Art Unit: 2731
Filed : June 10, 1997 Examiner: W. Luther
For : STM SWITCHING ARRANGEMENT

New York, New York
September 5, 2000

COMMUNICATION

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Prior to examination, consideration and entry of the following remarks are requested.

Regarding the Examiner's rejection under 35 U.S.C. §103 in the parent application, the Examiner relies on the combination of Takeuchi and Beshai. However, it is not apparent how such a combination could result in an arrangement which offered the attributes claimed by the Examiner. In the opinion of the applicants, such a combination would not be practical and *would not work*.

Turning to Beshai, the central element of the switch (18) comprises a set of packet buffers. These are connected to inputs and outputs via sets of input and output FIFO's (14, 16). Distribution of incoming packets among the various packet buffers is achieved by means of the input rotator. In introducing the concept of the rotator, Beshai states (col. 4, lines 3-7) that, due to the nature of the operation of the switch, both the outlet and the input "must rotate".

In contrast, in the system of Takeuchi, distribution of incoming packets is achieved by means of the bus 215. It is evident that rotators are *not necessary* for correct operation of the arrangement of Takeuchi.

The applicants would like to point out that these two methods of distribution -- rotator and bus -- are mutually incompatible and inclusion of both types of distribution in one system is contrary to common sense. If, for instance, it is proposed to include a rotator from Beshai at the input to the unit switches of Takeuchi (#1 - # P) any distribution thereby achieved would be changed by redistribution via the bus. If, as in Beshai, the rotator is able to achieve the desired distribution, then the bus of Takeuchi would appear to be redundant.

Following this line further: the rotator in Beshai would require addition of FIFO buffers at the inputs. If rotators were to be added to the outputs, then a similar argument applies and further FIFO buffers should be added here as well. In the resulting system therefore, the bus 215 and the FIFO buffers 2171 of the unit switches of Takeuchi would no longer be necessary. However, removing these features would arrive at a system substantially identical to that disclosed by Beshai, as distinct from any proposed combination of Beshai with Takeuchi. In fact, the characteristic features of Takeuchi are no longer present.

The applicants therefore respectfully disagree with the Examiner when he states that it would have been obvious to one of ordinary skill to adapt the ATM switch of Takeuchi in the light of Beshai. As shown above, such a combination is not practical.

Applicants also point out that, contrary to the statement by the Examiner, no suggestion can be found in Beshai to adapt the ATM switch of Takeuchi to STM switching.

Applicants respectfully maintain their argument, originally put forward in the Preliminary Amendment of March 6, 1995, that it is not possible to include rotators in Takeuchi by any simple means and any such suggestion by the Examiner has no foundation. Even if it were possible to include rotators in Takeuchi, this would *not* convert into an STM switch. There is *no* indication of how to carry out such a conversion. Indeed, this conversion does not appear possible.

The Examiner suggests that the ATM switch of Takeuchi can be converted into an STM switch on the basis of a reference to a hybrid STM/ATM switch in Beshai and that the rotor of Beshai can be added to the converted switch of Takeuchi, whereas there is no teaching in either Takeuchi or Beshai that the above can or should be carried out. Applicants restate their opinion that the Examiner appears to be attempting to conclude that the cited references anticipate or make obvious the combination of elements of the claims by the use of hindsight. The Examiner employs a quotation from case law implying that hindsight may be allowable so long it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. However, from the Examiner's argumentation, it is clear that the *only* indication to combine Takeuchi with Beshai is found in the arrangement of the present invention, and that the Examiner is using knowledge which was *not* available to the skilled person at the time the invention was made.

The Examiner is referred once again to the case law outlined in the Preliminary Amendment of March 6, 1995. This case law showing that the mere fact that a reference cited by an Examiner may be modified does not allow an Examiner to meet his burden for showing obviousness absent a suggestion in the cited art of the desirability of the modification. None of the cited references makes such a suggestion relative to the claims now presented. Moreover, it has been held that an Examiner "may not use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious".

Reconsideration and withdrawal of the outstanding rejection are respectfully requested.

Respectfully submitted,

KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C.

Attorneys for Applicant(s)

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Alan Israel

Registration No. 27,564



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

WM11/0813

JAMES DEAN JOHNSON
JONES & ASKEW
191 PEACHTREE STREET N E
37TH FLOOR
ATLANTA GA 30303-1769

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/872,078	06/10/97	006	LUTHER, W 2664	08/13/01
First Named Applicant	JEFFREY, 35 USC 154(b) term ext. = 0 days.			

TITLE OF STM SWITCHING ARRANGEMENT
INVENTION

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
2 P/54265/USP/	370-367.000	K47	UTILITY	NO	\$1240.00	11/13/01

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give application number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PATENT AND TRADEMARK OFFICE COPY



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/872,078	06/10/1997	MARK T. JEFFREY	P/54265/USP/	9030

23370 7590 05/06/2002

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

LUTHER, WILLIAM A

ART UNIT	PAPER NUMBER
----------	--------------

2664

PH 23

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/872,078

EXAMINER

ART UNIT	PAPER NUMBER
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P#23

DATE MAILED:

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
- ☐ A reply (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
- ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
- ☐ No reply has been received.
- ☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
- ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance.
- ☐ The submitted fee of \$ _____ is insufficient. A balance of \$ _____ is due.
The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d), is \$ _____.
- ☒ The issue fee and publication fee, if applicable, has not been received.
- ☐ Applicant's failure to timely file new formal drawings as required by, and within the three-month period set in, the Notice of Allowability (PTOL-37).
- ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
- ☐ The proposed new formal drawings filed on _____ are not acceptable and the period for reply has expired.
- ☐ No proposed new formal drawings have been received.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

ABANDONMENT

CONTACT PERSON IS:

TOM HAWKINS

205-2380

Interview Summary	Application No.	Applicant(s)	
	08/872,078	JEFFREY ET AL.	
	Examiner	Art Unit	
	John Pezzlo	2619	

All participants (applicant, applicant's representative, PTO personnel):

(1) John Pezzlo (3) _____

(2) Alan Israel (4) _____

Date of Interview: 07 August 2008.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: None.

Identification of prior art discussed: None.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

/John Pezzlo/
Primary Examiner, Art Unit 2619

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The history of the case was discussed and a time line of actions taken was determined. It was discovered during the interview that an allowance was issued (8/13/01) refer to attachment #1. However the allowance was mailed to the wrong attorney. Because the allowance was mailed to the wrong attorney the issue fee was not paid, resulting in an abandonment being issued 5/6/02, refer to attachment #2. The attorney needs to update the address information in the PTO to reflect the correct mailing address and attorney of record. Then the attorney needs to petition the PTO to revive the case.